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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,704	05/30/2000	George Peter Lomonossoff	DOW-04647	2167
23535	7590	06/01/2006	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			GUIDRY, GUY L	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/580,704	<b>Applicant(s)</b> LOMNONSSOFF, GEORGE	
	<b>Examiner</b> Guy Guidry, Ph.D.	<b>Art Unit</b> 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,4-9 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9 and 12-16 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt is acknowledged of a response filed 17 March 2006 to the Office Action mailed 15 November 2005.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 March 2006 has been entered.

Claims 1, 4-9, 12-16 are pending in this application. Claims 1 and 9 have been amended. Claims 1, 4-9, and 12-16 are under consideration in this Action.

#### ***Claim Objections***

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1, 4-9 and 12-16 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

***Response to Arguments and Amendments***

Applicant has amended claims 1 and 9 to recite a nucleotide sequence coding for a foreign peptide in a region that codes for an exposed part of the viral coat protein, overcoming. Applicant argues persuasively that the Porta et al. reference does not teach a peptide insertion in CPMV result in non-assembled virus particles. The Office does not agree with Applicant that Uhde et al. that oligonucleotide addition may occur at any site in any plant virus but rather N-terminal coat protein fusion protein in Potato X virus only. Uhde certainly does not provide information of any plant virus in any plant. The Office finds enabling support for Applicant's amendment to claims 1 and 9, narrowing epitope presentation to an exposed part of the virus coat protein. Therefore, this rejection of claims 1, 4-9 and 12-16 under 35 U.S.C. 112, first paragraph is **withdrawn**.

**Claims 1, 4-7, 9 and 12-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a**

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**way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

This is a new ground of rejection. The claims are drawn to a any plant infected with any modified plant virus wherein the viral the viral coat protein is modified to contain a foreign peptide in a region that codes for an exposed part of an expressed native portion of the plant viral coat protein. The Office notes that in order to generate the claimed recombinant virus coat protein nucleic acid necessarily requires detailed knowledge (atomic resolution by X-ray crystallography) of the coat protein sequence and specifically with nucleotides encode for amino acids that are "exposed". As the shift from exposed to non-exposed coat protein literally may occur from one amino acid to the next where the coat protein folds, a detailed knowledge of coat protein sequence as it related to tertiary protein structure is required.

Applicant is claiming an inventive step not known at the time of invention of the instant application. The Office finds that detailed atomic-level knowledge of a genus of plant coat protein sequence as they relates to protein structure was not known in prior to and in 1992 (see for example Uhde et al. of record, p. 328, ¶¶1-3). If Applicant is aware of art contradicting this rejection, Applicant is certainly encouraged to provide the Office such information of representative number of species plant coat protein sequences. The instant specification does not provide a written description of the genus of plant virus coat proteins or sufficient number or species to describe such a genus. Therefore, claims 1, 4-7, 9 and 12-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 9 and 12-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,874,087.**

This rejection was made previously. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims 9 and 12-16 are drawn to a genus of a method of producing a modified plant virus, while reference claims 1-9 are drawn to a species of a method of producing a modified plant virus. Species claims necessarily make obvious the broader genus claims.

**Claims 9 and 12-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-28 of U.S. Patent No. 5,958,422.**

This rejection was made previously. The same analysis as above applies here.  
The genus claims are necessarily made obvious by the species claims.

### ***Response to Arguments***

Applicant has suggested dividing claims 9 and 12-16 into a separate application with a terminal disclaimer. The Office reminds Applicant that in such a situation, claims 9 and 12-16 of the prospective new application would still be subject to possible double patenting rejection.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Guy Guidry, Ph.D. whose telephone number is 571-272-7928. The examiner can normally be reached on Monday through Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) (<http://pair-direct.uspto.gov>) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.




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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Guy Guidry, Ph.D.

Examiner

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**DANIEL M. SULLIVAN**  
**PATENT EXAMINER**